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REMARKS

INTRODUCTION

Claims 1-9 and 11-15 were previously and are currently pending and under consideration.

Claims 1-9 and 11-15 are rejected.

Claims 1, 6, 8, 11, and 14 are amended herein.

No new matter is being presented, and approval and entry are respectfully requested.

REJECTIONS UNDER 35 USC § 103

In the Office Action, at pages 4-5, claims 1, 5-6, 8, 11 and 15 were rejected under 35 U.S.C. § 103 as being obvious over Gase in view of Yacoub.

At pages 5-6, claims 2, 7 and 9 were rejected under 35 U.S.C. § 103 as being obvious over Gase in view of Yacoub and further in view of Ooki.

At page 6, claims 3, 4 and 12-14 were rejected under 35 U.S.C. § 103 as being obvious over Gase in view of Yacoub and further in view of Nishizawa.

These rejections are traversed and reconsideration and is requested.

CLIENT OBTAINING COMMAND LIST AUTOMATICALLY IN RESPONSE TO AN OPERATION COMMAND/REQUEST, AND USING THE THUS-OBTAINED COMMAND LIST (SET OF OPERATING INSTRUCTIONS) TO PREPARE THE COMMAND INSTRUCTION TO CARRY OUT THE OPERATION COMMAND

Amended claim 1 recites that when a client initiates a discrete command such as a print command, the client first automatically requests a command list (set of operating instructions) from the server, and then, to complete the same command, the client uses the received command list to generate the actual command instruction which is the sent to the printer via the server. Therefore, a client lacking the command list for a peripheral can nonetheless accept and process a command for the peripheral without disturbing the user. In other words, between

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receiving the command (e.g. from a user) and issuing a corresponding command instruction to the server, the client automatically retrieves the command list and uses it for the command instruction.

Support for this understanding is found at least at Figure 7, and at pages 11-13 of the specification. Page 11 notes that "the client computer 101 receives a command for operating the printer... sends a request for a command list ... When the client computer 11 receives the command list 116b of the printer... the client computer 101 generates a command corresponding to an operation which the printer should be instructed to perform". Furthermore, the effect is described as "supplying the command lists ... to the client computer 101 as necessary from the server computer ... the client computer 101... does not need to store the command lists" (page 13, lines 24-29). See also page 8, lines 19-21, stating that "[w]hen the client computer 101 receives a command for operating the printer 103, the client computer 101 sends a request for a command list".

Pending claims 14 and 15 recite a similar feature of fetching a command list to respond to a peripheral command. However, the Office has not directly addressed the fact that a client can automatically handle a command even if it does not initially have a command list (set of operating instructions) necessary for the command.

Although Gase discusses obtaining a driver for a client, in Gase the driver is only obtained when the user manually selects a new default printer using client utility 24. More specifically, in Gase, when a print job is requested, a printer selection interface 50 is presented by utility 24. If a new default printer is selected and set, only then does the utility 24 retrieve the driver. This is different than the present invention, which appears to retrieve the set of operating instructions in automatic response to a command to operate the peripheral. Gase requests a driver not in response to a command to operate the peripheral, but rather in response to a user selecting the printer from a list of printers. See column 6, lines 8-12, and column 4, lines 60-65.

Unlike claims 1, 6, 8, and 11, 14, and 15, Gase does not discuss or suggest that the set of operating instructions is retrieved automatically in response to the command at the client to operate the peripheral device.

Withdrawal of the rejection is respectfully requested.

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OOKI DOES NOT DISCLOSE A PRINTER DRIVER STORED IN A PRINTER

The rejection characterizes column 6, lines 4-20 of Ooki as teaching "that information relating to the characteristics of a printer includes the printer driver and that information relating to the characteristics of a printer may be stored in a ROM or the like of the printer" (Office Action, end of page 5 to top of page 6).

The cited portion of Ooki actually states that "information relating to characteristics of printers stored in the printer-information storage unit 104 ... may be distributed in the form of a vendor of an operating system, [or in the form of] part of printer-driver software provided by a maker of printers, or the like. Alternatively, information relating to characteristics of each printer 101 may be stored in a ROM or the like of the printer". The printer characteristic information is used for the purpose of printer selection. Furthermore, Figure 5 of Ooki shows that selection characteristics do not include or relate to a driver, and column 5, lines 61-65 show that printer characteristic information includes items such as speed, quality, gradient, font etc., which are distinctly different than operating instructions or a driver. Clearly, "characteristics" are properties of the printer, not a driver for the printer.

In view of the above, the Office's statement that "characteristics of a printer includes the printer driver" is incorrect. A printer driver is mentioned in Ooki as software accompanying the characteristic information in some form of distribution, such as an operating system install disk or a disk for installing printer software including a printer-driver. In other words, a distribution of software may include both a driver and printer characteristic information, but Ooki only discloses printer characteristics being stored in the printer. Furthermore, ROMs are read-only. Read-only storage of characteristics that are not likely to change (e.g. printer speed, quality) makes is reasonable. However, it would not be practical to store a driver in ROM, because, as mentioned in Gase, drivers often require frequent upgrades. Upgrades are not possible in ROM, which stands for Read Only Memory.

Withdrawal of the rejection is further respectfully requested.

OBVIOUSNESS

Applicant previously argued that the references were combined without motivation. The Office responded by citing case law and remarking that a motivation need not be found in a prior

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art *reference*. The Examiner's remarks do not correctly reflect Applicant's argument or the law regarding motivation to combine. An examiner must provide a motivation *from the prior art* before the invention, and the motivation must suggest the desirability of the combination. The motivation cannot be a benefit that is apparent only after the combination is made. The motivation must come from the prior art, which may be in the form of references, alleged common knowledge, or a combination thereof. However, the current rejections do not even explain the basis for the provided motivations to combine the references. In the Office Action, see page 5, lines 10-14, page 6, lines 3-5, and page 6, lines 14-16. For example, it is suggested that including processing results "would have allowed greater user control and information". There is no explanation of how this conclusion is reached. Furthermore, if "greater user control and information", "this would have allowed for quickly adding of new printers", etc. are not proper motives. If such general motives were acceptable, then almost any invention would become obvious.

In view of MPEP § 2143.01, which notes "the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references", so that clear issues can be developed, Applicant respectfully requests a statement of the Examiner's specific factual findings regarding the motivations to combine the prior art references. For example, what factual finding supports the conclusion that a print completion message would have allowed greater user control and information; user control of what, greater information of what? What factual finding supports the conclusion that one skilled in the art would have used printer characteristics (as explained above) to add new printers?

DEPENDENT CLAIMS

The dependent claims are deemed patentable due at least to their dependence from allowable independent claims. These claims are also patentable due to their recitation of independently distinguishing features. For example, claim 3 recites "a communication protocol accommodation part which accommodates a difference between communication protocols of said client and said peripheral apparatus to be operated by said operating client". This feature is not taught or suggested by the prior art. Withdrawal of the rejection of the dependent claims is respectfully requested.

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CONCLUSION

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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CERTIFICATE OF FACSIMILE TRANSMISSION

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on August 30, 2004

STAAS & HALSEY

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Date: August 30, 2004